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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,498	11/13/2000	Ryuzo Tomomatsu	198487US0XPC	1427

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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LEE, RIP A

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 10/31/2003

16 KB

Please find below and/or attached an Office communication concerning this application or proceeding.

16 KB

**Office Action Summary**

Application No.

09/674,498

Applicant(s)

TOMOMATSU ET AL.

Examiner

Rip A. Lee

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 May 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14.                      6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 19, 2003 has been entered.

2. Applicant's disagreement with examiner's reasons for allowance has been reviewed, and the conclusion drawn from the prior art was shown to be incorrect. Examiner reasoned that because the propylene composition of Tomomatsu *et al.* contained only 1-17 wt % of ethylene, it is not possible that the xylene-soluble fraction could contain the claimed 33-39 wt % of ethylene. Examiner concurs that such a conclusion is incorrect. Consequently, the allowance set forth in the previous office action (Paper No. 9) has been withdrawn.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 6,034,165 to Tomomatsu *et al.*

The prior art of Tomomatsu *et al.* discloses a propylene-based resin composition comprising 42-95 % (by weight) of a propylene-based resin, 1-10 % of an ethylene-C<sub>3</sub>-C<sub>18</sub>  $\alpha$ -olefin copolymer, and 2-35 % by weight of talc. The propylene-based resin comprises from 70-98 % by weight of a fragment insoluble in *p*-xylene at 23 °C and 2-30 % by weight of a fragment soluble in *p*-xylene at 23 °C. The former fraction has a relaxation time  $\tau$  of 0.01-0.35 s at an angular frequency  $\omega$  of 10 %/s and a PDI of 1-18. The *p*-xylene insoluble fraction has a limiting

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viscosity in decalin (135 °C) of 2.0-10 dL/g (claims 1 and 2). An automobile trim member is produced by injection molding of the propylene-based resin composition (claim 5).

The reference is silent with respect to the isotactic pentad fraction of the *p*-xylene insoluble fraction. However, in view of the fact that: (i) entire resin has an isotactic pentad fraction of at least 95 % (claim 1), (ii) such a fraction is not likely to be soluble in *p*-xylene, (iii) the methods outlined for preparing the propylene-based resin is essentially the same as that of the present invention, sufficient evidence exists to believe that the prior art composition also possesses *p*-xylene insolubles which have an isotactic pentad fraction of greater than 95 %. Since the PTO can not conduct experiments, the burden of proof is shifted to the Applicants to establish an unobviousness difference. *In re Fitzgerald*, 619 F.2d. 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112-2112.02.

The reference does not indicate the ethylene content of the *p*-xylene soluble fraction. Nonetheless, the ethylene unit content of the entire propylene-based resin is 1-17 % by weight (claim 2). As the *p*-xylene insoluble fraction is not likely to be a major contributor to the total ethylene content, it can be inferred that the ethylene content of the *p*-xylene soluble fraction is likely to contain the claimed weight percentage. Since the PTO can not conduct experiments, the burden of proof is shifted to the Applicants to establish an unobviousness difference. *In re Fitzgerald*, 619 F.2d. 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112-2112.02.

***Information Disclosure Statement***

Reference EP 0 916 701 to Sakai *et al.* teaches a resin composition comprising: (a) 3-65 wt % of a *p*-xylene (23 °C) soluble component, (b) 35-97 wt % of a *p*-xylene (23 °C) insoluble component, and (c) 0-30 wt % of a *p*-xylene (135 °C) insoluble component. Component (a) is composed of a substantially elastomeric constituent. Component (b) is composed substantially of a crystalline polypropylene constituent having *mmmm* of greater than 97 %, and PDI of 6 or higher. Component (c) is filler such as talc.

A notable difference between the composition of the present claims and the product of Sakai *et al.* is the nature of the propylene component. According to the present claims, the polypropylene-based resin must also contain a *p*-xylene soluble fraction, and that fraction must contain an ethylene content of 33-39 wt %. According to Sakai *et al.*, however, component (b) does not appear to contain a *p*-xylene soluble fraction. That it may actually contain such a component is not obvious in view of the disclosure, and hence, the examiner deems that the subject matter of the prior art is neither anticipated by, or obvious over, Sakai *et al.*

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***Prior Art***

The prior art made of record but not relied upon is considered pertinent to the Applicant's disclosure. The following references have been cited to show the state of the art with respect to polypropylene/talc compositions characterized by solubility of constituents in certain solvents.

U.S. Patent No. 5,750,612 to Zyagawa *et al.*

U.S. Patent No. 5,308,908 to Fukui *et al.*

U.S. Patent No. 5,283,267 to Nishio *et al.*

U.S. Patent No. 5,086,109 to Ueno *et al.*

U.S. Patent No. 4,948,841 to Kasahara *et al.*

U.S. Patent No. 4,769,284 to Kakugo *et al.*

U.S. Patent No. 4,694,031 to Morita *et al.*

U.S. Patent No. 4,504,617 to Yui *et al.*


U.S. Patent No. 4,439,573 to Fukui *et al.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (703)306-0094. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)746-7064. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

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October 27, 2003

  
**PETER D. MULCAHY**  
**PRIMARY EXAMINER**